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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,425	05/24/2001	Andrew J. Vilcauskas JR.	Exit:Post1	5992
152	7590	07/12/2005	EXAMINER	
CHERNOFF, VILHAUER, MCCLUNG & STENZEL 1600 ODS TOWER 601 SW SECOND AVENUE PORTLAND, OR 97204-3157			WASSUM, LUKE S	
			ART UNIT	PAPER NUMBER
			2167	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,425

Applicant(s)

VILCAUSKAS ET AL

Examiner

Luke S. Wassum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20041210, 20050517.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 June 2005 has been entered.

Priority

2. The Applicants' claim to domestic priority under 35 U.S.C. §119(e), to provisional application 60/207,698, filed 26 May 2000, is acknowledged. Since the subject matter of the parent provisional application encompasses that of the instant application and claims, a priority date of 26 May 2000 is hereby established.

The Invention

3. The claimed invention is drawn to a method of presenting advertisements in a computer system through the use of popunder windows. Alternative claimed embodiments are implemented in other media, such as a PDA, telephone, television and radio.

Information Disclosure Statement

4. The Applicants' Information Disclosure Statement, filed 10 December 2004, has been received and entered into the record. However, the Information Disclosure Statement fails to comply with the provisions of MPEP § 609, and particularly 37 C.F.R. § 1.98(a)(2), which requires a

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copy of each cited foreign patent and each cited non-patent document. Additionally, a number of the cited U.S. Patent documents contained typographical errors (the examiner presumes) in the patent numbers, as evidenced by inconsistencies between the cited patent numbers and patentees.

All documents cited for which copies were furnished to the Office have been considered.

See attached form PTO-1449.

5. The Applicants' Information Disclosure Statement, filed 17 May 2005, has been received and entered into the record.

The Information Disclosure Statement cited a single document, "Netscape2 Unleashed", a document of some 900 pages.

The provisions of MPEP § 609 include that "Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, *relevant pages of the publication*, date, and place of publication (emphasis added). See 37 C.F.R. § 1.98 (a)(2)(b)(5).

Given the 900 page length of the reference, the examiner assumes that the entire reference is not relevant. Since the Applicants have failed to cite the relevant pages of the publication, as required by § 609, the reference has not been considered by the examiner. See attached form PTO-1449.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

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subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Landsman et al.** (U.S. Patent Application Publication 2003/0004804) in view of **Porn Rodeo** ("source code of www.pornrodeo.com as of 15 November 1999").

10. Regarding claim 21, **Landsman et al.** teaches a system for Internet advertising for use in a media capable of simultaneously maintaining a foreground window and at least one background

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window and capable of displaying a first browser in a said foreground window for selectively browsing the Internet substantially as claimed, said system comprising:

- a) a script handler that invokes a post-session procedure in said first browser (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B); and
- b) an event handler that receives, from an Internet address, a link to an advertisement and loads said advertisement (see paragraphs [0003], [0016], [0017], [0036]-[0038], [0087], [0095], [0107] and [0109]).

Landsman et al. does not explicitly teach a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Porn Rodeo, however, teaches a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window (see window.open and window.focus calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would allow the display of the advertisement to the user (by moving the browser window to the

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foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

11. Regarding claim 31, **Landsman et al.** teaches a post-session advertising method for use in media capable of simultaneously maintaining a background window and a foreground window, said method comprising the steps of:

- a) embedding post-session instructions into a first browser, said first browser for being displayed in said foreground window (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B);
- b) said post-session instructions receiving, from an Internet address, a link to an advertisement (see discussion of a request for, and receipt of, an AdDescriptor file, a text file containing a list of file names and corresponding URLs at which these files reside, paragraphs [0103] through [0107]); and
- c) loading said advertisement (see paragraph [0107]).

Landsman et al. does not explicitly teach a method wherein said post-session instructions open a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Porn Rodeo, however, teaches a method wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said

foreground window, and wherein said advertisement is loaded into said second browser in said background window (see window.open and window.focus calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would allow the display of the advertisement to the user (by moving the browser window to the foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

12. Regarding claims 22 and 32, **Porn Rodeo** additionally teaches a system and method wherein said second browser is opened in response to a load-triggering event (see window.open call on page 1, lines 16-17, showing that the load-triggering event was the loading of the porn rodeo web page).

13. Regarding claims 23 and 33, **Porn Rodeo** additionally teaches a system and method wherein said load-triggering event comprises at least one of clicking on an off-site link, entering a new address, refreshing a web site, exiting a web site, and being redirected to a web site (see window.open call on page 1, lines 16-17, showing that the load-triggering event was the loading of the porn rodeo web page, analogous to both refreshing a web site and being redirected to a web site, since both would entail the loading of the web page).

14. Regarding claims 24, 25, 34 and 35, **Landsman et al.** additionally teaches a system and method wherein said script handler delays invocation of said post-session procedure for a predetermined period of time, and wherein said script handler cancels invocation of said post-

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session procedure if a user loads a new web site in said first browser before said predetermined time period has elapsed (see disclosure of the timer based frame targeted advertisements, paragraph [0159]).

15. Regarding claims 26 and 36, **Landsman et al.** additionally teaches a system and method wherein said second browser is displayed in a foreground window after the occurrence of a view-triggering event (see paragraphs [0037] and [0038]).

16. Regarding claims 27 and 37, **Landsman et al.** additionally teaches a system and method including a focus timer that tracks the duration that said second browser is displayed in said foreground window (see paragraph [0050]).

17. Regarding claims 28 and 38, **Landsman et al.** additionally teaches a system and method wherein said media comprises one of a computer, a PDA, a cell phone and a television (see disclosure that the system is executed in a computer, Abstract).

18. Regarding claims 29 and 39, **Landsman et al.** additionally teaches a system and method wherein said event handler selects and returns one of a plurality of advertisements maintained at said Internet address (see paragraph [0104]).

19. Regarding claims 30 and 40, **Porn Rodeo** additionally teaches a system and method capable of opening a plurality of second browsers, each maintained in a separate background window, said event handler capable of receiving a link to an advertisement for each browser and loading a

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respective said advertisement into each said second browser while each said second browser remains in its respective said background window (see window.open and window.focus calls on page 1, lines 15-20, code that would open an additional background window each time the web page was refreshed).

Response to Arguments

20. Applicant's arguments filed 6 June 2005 have been fully considered but they are not persuasive.

21. Regarding the Applicants' argument that the examiner has failed to provide motivation for the combination of references, the examiner respectfully responds that the motivation as stated in the rejection of record is proper. Even given the advantageous loading of advertisement and media and player files onto local disk or cache, actually loading them into an instantiated background window (as disclosed by the **PornRodeo** reference) and popping that window to the foreground would be faster than loading said advertisement and media and player files into the current browser for rendering (as disclosed in the **Landsman et al.** reference).

22. Regarding the Applicants' argument that neither the **PornRodeo** nor the **Landsman et al.** reference includes any means by which a background window may be superimposed over a foreground window, the examiner respectfully responds.

The **Landsman et al.** reference teaches a system by which advertisements are displayed 'politely', during an interstitial period, that being the period when a newly requested web page is being downloaded to the user's web browser. Note that the web browser recognizes the start of the

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disclosed 'interstitial' by a triggering event, such as the typing of a new URL into the browser, the clicking on a link, the clicking of the forward or backward buttons of the browser, etc. Such triggering events are disclosed by the Applicants as analogous 'view triggering events' in the specification (page 17, lines 4-22).

All of the limitations claimed in the independent claims (at least) by the Applicants are disclosed by the **Landsman et al.** reference, with the exception that the advertisement is loaded into a the cache or local disk and the loaded into the foreground browser instead of the claimed limitation that the advertisement is loaded into a background browser window.

The **PomRodeo** reference teaches in general the use of a popunder window for the display of an advertisement, and in particular the code to create a new window, to load an advertisement into the new window, and to refocus the original (foreground) window, thus effectively creating a window in the background.

The Applicants note in their arguments that neither reference teaches any means by which a background window may be superimposed over a foreground window.

The examiner responds that for the purpose of anticipating the claims, this limitation is not claimed by the Applicants, only that the second window is displayed in the foreground after a view-triggering event, which according to the specification includes, for example, closing the foreground window. This does not require the background window to be superimposed over a foreground window.

For the purposes of supporting a motivation to combine the references of record, the examiner notes that, as stated in the rejection of record, moving a pre-loaded background window to the foreground, instead of having to load content/media/players from cache or local disk into the

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foreground browser, would be faster. Furthermore, regarding the fact that the teaching provided by the **PornRodeo** reference (that an advertisement can be loaded into a background window) lacks explicit disclosure "by which a background window may be superimposed over a foreground window", such a capability existed and its use would most certainly have been obvious to one of ordinary skill in the art at the time of the invention, through the `window.focus()` function.

The examiner has changed the secondary reference from the **PornRodeo** source code as of 13 October 1999 to that of 15 November 1999, since this code more explicitly allows for the use of the `window.focus()` function for the background browser, through the use of the label 'amasho' for the newly created window (see lines 16-18).

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alberts (U.S. Patent 5,937,392) teaches an Internet advertising system having a database, a controller and an ad server operating as part of a web server.

Merriman et al. (U.S. Patent 5,948,061) teaches a method for targeting the delivery of advertisements over a network such as the Internet.

Slotznick (U.S. Patent 6,011,537) teaches a system for displaying information at a display of a local user computer.

Horstmann (U.S. Patent 6,285,985) teaches a mechanism allowing a software developer to present advertisements through a software program.

Roth et al. (U.S. Patent 6,285,987) teaches a system for providing advertisements from a central server to viewers who access web sites.

Shuster (U.S. Patent 6,389,458) teaches a method for directing an on-line user to predetermined information.

Yacoby et al. (U.S. Patent 6,516,311) teaches a method of finding a web page based on telephone numbers with a feature of utilizing the finding method to build traffic to view advertisements.

Gabbard et al. (U.S. Patent 6,633,850) teaches an advertisement system for inserting into an end user communicating message a background reference to an advertisement.

Shuster (U.S. Patent 6,763,379) teaches a system for monitoring a user's activities and displaying unsolicited content to users over a wide area network.

McElfresh et al. (U.S. Patent 6,907,566) teaches a method for placement of graphical objects on a page to optimize the occurrence of an event associated with such objects.

Wen (U.S. Patent Application Publication 2001/0047297) teaches a method of remotely creating an advertisement in a distributed communications network.

Robinson (U.S. Patent Application Publication 2001/0054001) teaches a system for targeting advertising.

Lamont (U.S. Patent Application Publication 2002/0072972) teaches an advertisement including preliminary and delayed content.

Shuster (U.S. Patent Application Publication 2005/0021612) teaches a system for monitoring a user's activities and displaying unsolicited content to users over a wide area network.

Merriman et al. (International Publication WO-98/58334-A1) teaches a computer system for automatic replacement of direct advertisements in scarce media and includes an advertising server for selecting a direct advertisement based on certain criteria.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
29 June 2005